

AUG 21 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP 1600

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In re application of: Luo et al.

Group Art Unit: 1645

Serial No. 09/041,236

Examiner: Lee, L.

Filed: Mar 11, 1998

Attorney Docket No. EX98-001

For: *Semaphorin K1*

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted by fax to
(703)308-4242 on August 21, 2000

Signed

Richard Osman

RESPONSE

The Assistant Commissioner for Patents
Washington, DC 20231

Dear Commissioner:

Thank you for the Action mailed 8/15/00. As a point of reference, this is the third Action to raise new issues in this application.

The claims are newly rejected under 35USC101 as supposedly unsupported by either a specific and substantial asserted utility or a well-established utility. The claims are directed to novel polypeptides comprising a sequence specific to a human protein (Semaphorin K1) which regulates nerve and immune cell function in vitro and in vivo. The Specification shows how these polypeptides are used in therapeutic applications to enhance organotypic neurite outgrowth from damaged neurons undergoing nerve fiber atrophy (p.18, lines 6-16), in drug screens (p.11, lines 3-12), to generate Semaphorin K1 specific polynucleotide hybridization probes, to make Semaphorin K1-specific antibodies (p.5, line 19 - p.6, line 31), etc. Such antibodies and probes provide both diagnostic (p.10, lines 26-31; p.7, lines 13-19) and therapeutic (p.18, lines 16-29) applications.

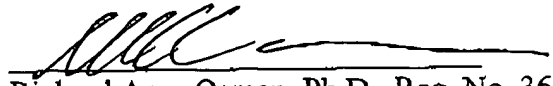
The Action's suppositions are contrary to fact: the specification does teach specific and substantial utility of the claimed compositions; manufacturing diagnostic probes and treating nerve fiber atrophy are "real world" applications and particular disease states are specified.

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The Action's pro forma rejection under 35USC112, first paragraph, premised entirely on the 35USC101 rejection is similarly without support and contrary to the teachings of the Specification.

Upon allowability of the product claims of Group I, Applicants request rejoinder of non-elected Group III claims 19-22.

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP


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